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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,688	04/04/2000	Nimesh Desai	21118037	6165
36614 7590 05/10/2007 MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304			EXAMINER GELAGAY, SHEWAYE	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 05/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/542,688	Applicant(s) DESAI ET AL.	
	Examiner Shewaye Gelagay	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on March 2, 2007. Claim 27 has been amended. Claims 25-27 are pending.

Requirement for Information

2. Applicant's arguments filed March 2, 2007 have been considered but are moot in view of the new ground(s) of rejection. In response to the arguments concerning the previously rejected claims, the following comments are made:

In response to applicant's arguments, the recitation that "selective real-time information exchange of member profile information between external network devices and information exchange system" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The applicant argued that Dedrick fails to disclose a method for an exchange of information with external network device. The examiner respectfully disagrees. Dedrick teaches the system may also have a publisher unit and servers of the WAN (i.e. external network) system that allows the server and publisher unit to transfer

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information (i.e. exchange information). The publisher unit and servers of the WAN system contain the interface hardware and software necessary to transfer electronic information between the components of the system. The system may have multiple client systems coupled to multiple servers. (col. 3, lines 1-36)

In response to applicant's arguments, the recitation that "pushing information from external network devices" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Dedrick U.S. Patent 5,717,923.

As per claim 25:

Dedrick teaches a network including a plurality of network devices operated by a plurality of users, a method for retrieving member profile information that provides for selective real-time information exchange of member profile information between external network devices and an information exchange system comprising the steps of:

granting, by a member, access to at least one data element associated with the member from the external network devices; (col. 6, lines 4-7; col. 7, lines 57-65)

retrieving the data elements associated with the member from the external network device to the information exchange system; (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35) and

storing the data elements on the information exchange system to automate access to member profile information from the external network device. (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35)

As per claim 26:

Dedrick teaches a network including a plurality of network devices operated by a plurality of users, a method for retrieving member profile information that provides for selective real-time information exchange of member profile information between external network devices and an information exchange system comprising the steps of:

granting, by a member, access to at least one data element associated with the member from the external network devices; (col. 6, lines 4-7; col. 7, lines 57-65)

snarfing the data elements associated with the member from the external network device to an information exchange system; (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35) and

emulating the member profile on the information exchange system to automate access the external network device. (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35)

As per claim 27:

Dedrick teaches a network including a plurality of network devices operated by a plurality of users, a method for pushing selected member profile information that provides for selective real-time information exchange of information between network devices of a member and at least one selected vendor comprising the steps of:

authorizing, by a member, a subset of data elements associated with the member; (col. 6, lines 4-7; col. 7, lines 57-65)

providing the subset of data elements to a recommendation engine; (col. 3, lines 43-55)

converting, by the recommendation engine, the subset of data elements to an information request; (col. 3, lines 55-67; col. 8, line 20-col. 10, line 59)

forwarding the information request to the selected vendors; (col. 3, lines 55-67; col. 8, line 20-col. 10, line 59)

receiving recommendation information returned from the selected vendors; (col. 3, lines 55-67; col. 8, line 20-col. 10, line 59) and

presenting to a member, a subset of the recommendation information received by the recommendation engine. (col. 3, lines 55-67; col. 8, line 20-col. 10, line 59)

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shewaye Gelagay


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER